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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/748,843
Filing Date: December 27, 2000
Appellant(s): HANAOKA ET AL.

Katherine R. Vieyra
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/16/06 appealing from the Office action
mailed 8/23/05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

While the Brief correctly states that claims 1 and 3-14 are rejected and claim 2 is canceled, all of claims 1 and 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al in view of Dougherty et al. Gerace forms no part of the appealed rejection (claim 6 or otherwise).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,546,418	SCHENA et al	4-2003
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6,587,859	DOUGHERTY et al	7-2003
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Definition of "bookmark" and "bookmark file", "Computer Dictionary", Microsoft Press, Third Edition, 1997, page 58.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schena et al (418) (US6546418) in view of Dougherty et al (US6587859).

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Regarding claims 1, 3, 6, Schena et al (418) teaches methods and apparatus for scanning printed codes (such as barcode images) which are processed by an extraction element which decodes an associated URL that is used to retrieve advertising information over a network and display it to the user on the apparatus [abstract, 6:19-21]. Schena et al does not teach displaying the scanned image on the apparatus. Schena et al *does* however teach that the user device scans the codes for immediate or delayed processing or for reference and that *the links may be collected, sorted and prioritized locally by the user's device* [10:7-12, 43-47] [Note that the user's device may incorporate the scanner and receiver 180 as a single unit – col 6 lines 2-3]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the history of scanned links as recallable bookmarks so that a user could recall the collection of collected, sorted and locally stored links for future reference, in a manner as is well known with bookmarking websites. Dougherty et al also teaches scanning physically printed code in a publication whereby scanning the code with an optical scanner directs the user to a website for more information [abstract, fig 10, 4:54-67, 5:1-6]. Dougherty et al teaches that the scannable codes may have machine readable content (an embedded URL link) *as well* as human-readable image content (graphical icon) that indicate the destination content and/or destination format in the form of a “multicon linkmark” [Note the baseball of Dougherty et al's fig 10 indicates to the user that by machine-scanning the code of fig 10, the system will automatically link the user to sports-related website content – col 11 lines 19-31 of Dougherty et al]. It would have been obvious to one of ordinary skill at the time of the invention to have included such

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human-readable image content (icons) within the machine-scannable code (embedded URLs) of Schena et al (418) so that the suggested collection of bookmarked links are more user-friendly and users can determine what content is available at the destination. It would have been obvious to one of ordinary skill at the time of the invention to have displayed such image-embedded "multicon linkmarks" on the display so that Schena et al's suggested collection of collected, sorted and locally stored links identified and selected/launched in order to re-visit web content previously visited.

Regarding the claim 1 preamble, no limitation is provided in the body of the claim to require "portable"; the language in the preamble is not taken to breathe life into the claim and is not taken as limiting. Nonetheless, the apparatus of Schena et al (418) is taken to be "portable" and capable of being moved.

Regarding claims 4, 5, 7, Schena et al (418) teaches the use of a network url to display advertising on a web page [9:1-5]. The printed publication that includes the coding is taken to provide an article. The displayed content may be video [2:30-56].

Regarding claims 8-11, 13, 14, Schena et al (418) teaches that displayed ads are tracked for billing purposes. It would have been obvious to one of ordinary skill at the time of the invention to have provided an accounting server with charge table (database) to keep track of the billing. Schena et al (418) teaches that the billing may be based on the advertising selected and the number of impressions (access number). Official Notice is taken that it is well known to charge for advertising based on other functions such as time of day, the referring article content and the type of ad. It would have been obvious to one of ordinary skill at the time of the invention to have based

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advertising billing on any of these methods in order to charge the advertiser for the provided ads. Further, Schena et al (418) teaches sharing revenue/fees among all involved parties including bandwidth carrier (ISP provider), advertiser, content provider, etc. It would have been obvious to one of ordinary skill at the time of the invention to have charged the publisher for any portion of any required ISP connection charges so as to reduce/eliminate ISP connections charged for the user – a practice which is well known.

Regarding claim 12, Schena et al (418) teaches that the advertising/content displayed may be tailored to the user according to the user's location [7:15-20].

(10) Response to Argument

Applicant argues that Schena et al does not teach an image stored in memory and displayed as a bookmark. Examiner agrees as indicated by the obviousness rejection (rather than by arguing Schena et al anticipates the claims). However, as set forth in the rejection, Schena et al provides desire for a collection of collected, sorted and locally stored links to website content which would motivate one of ordinary skill to manage this collection of links in the manner notoriously known as bookmarks¹ – i.e. a displayed list of links that can be used to re-visit websites/URLs when desired.

Therefore displaying a list of collected links to the user of Schena et al is taken to have been obvious at the time. However, the claim calls for a display of a bookmark “image”

¹ Applicant clearly agrees that bookmarks were notoriously known - as the instant specification describes using bookmarks without any specific discussion defining what they are or teaching how to implement them, yet the examiner considers the disclosure enabling in this regard. Lastly, applicant's citation of FOLDLOC's definition of “bookmark” supports that bookmarks were notorious at the time of the invention.

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rather than merely a textual entry in a list of bookmarked links. Dougherty et al provides an important teaching that multicon linkmarks can serve as machine-readable links to website content as well as can include visual elements that help a human user understand what content to expect at each link's destination. It is this teaching (associate images/icons with web links) that one of ordinary skill would find obvious to include with the displayed collection of bookmarked links (an otherwise textual-based list of URLs). Therefore an image stored in memory and displayed as a bookmark is obvious.

Applicant argues that a bookmark is defined as a reference to a document in the form of a URL and a title or comment string, yet the definition provided by applicant indicates that a bookmark is **usually** in this form which indicates that bookmarks can be provided in other forms. While the examiner does not disagree that bookmarks at least sometimes include a title for example, he asserts that a bookmark's crucial feature is the marking of a page; this is consistent with the rejection. Bookmark titles and descriptions are taken to be optional in general use. In support of this, Examiner has cited "Computer Dictionary", Microsoft Press, Third Edition, 1997, page 58 which states:

- Bookmark: 2. In Netscape Navigator, a link to a Web page or other URL that a user has stored in a local file in order to return to it later.
- Bookmark file: 1. A Netscape Navigator file containing the addresses of preferred Web sites.

As can be seen, these require a "link/address" to a web page, but not necessarily a title or descriptor.

Further, it is pointed out that applicant intentionally removed (via 6/6/2005 claim amendment) all references to claim language that required "title information for said

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access destination information". Therefore it is clear that the current claim scope is not limited to require any title information associated with a bookmark. Applicant continues and focuses on her conclusion that a bookmark is complex and comprises two parts – a link and a descriptor **such as** (hence open-ended examples including) a title or other text. Examiner dismisses the 'complex' aspect as both parties seem to agree that bookmarks are actually routine and notorious for ordinarily skilled individuals. More importantly Examiner notes that the rejection sets forth displayed bookmarks with two parts – a link and an "image" (acting as a "descriptor") in the manner of Dougherty et al's multicon linkmarks.

Applicant argues that additional knowledge would be needed to create a bookmark given Schena et al and Dougherty et al, yet fails to describe any particularly daunting steps that would be required to be overcome. Examiner counters that one of ordinary skill would be capable of combining the references in order to provide an operative combination. "It must be presumed that the artisan knows something about the art apart from what the references disclose. In re Jacobv, 309 F.2d 513, 135 USPQ 317 (CCPA 1962). The problem cannot be approached on the basis that artisans would only know what they read in references; such artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby. Also, the conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint of suggestion a particular reference. In re Bozek, 416 F.2d 1385, USPQ 545 (CCPA 1969). And, every reference relies to some extent on knowledge or persons skilled in the art to

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complement that which is disclosed therein. In re Bode, 550 F.2d 656, USPQ 12 (CCPA 1977)."

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey D. Carlson



Conferees:

Eric Stamber



Donald Champagne

